

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: May 16, 2003

EAD

Opposition No. 125,458

Pioneer Kabushiki Kaisha
d/b/a Pioneer Corporation

v.

Hitachi High Technologies
America, Inc., by change of
name from Nissei Sangyo
America, Ltd.¹

Elizabeth A. Dunn, Attorney:

This case comes before the Board on opposer's motion to compel answers to interrogatories and document requests, filed October 30, 2002, and opposer's renewed motion to compel answers to interrogatories and document requests, filed February 7, 2003.² Both motions have been fully briefed.

The Board's April 29, 2002 institution and trial order set discovery to close on November 15, 2002. On August 7,

¹ The defendant portion of the caption has been amended to reflect applicant's merger and name change as recorded with the PTO Assignment Branch (Reel 2515, Frame 0061).

² The delay in acting upon this matter is regretted. Proceedings have been considered suspended as of applicant's filing of the October 30, 2002 motion to compel. See Trademark Rule 2.120(e)(2).

2002, opposer served applicant with opposer's first set of interrogatories and document requests. On September 11, 2002, applicant served its discovery responses.

In its responses to Interrogatory Nos. 40, 41, 42, and 43, and Document Request Nos. 15, 16, 17, applicant objected to providing information regarding its use of its mark on "computer monitors" because "computer monitors are not covered by the description of goods in the application at issue in this Opposition." By letter dated October 2, 2002, opposer requested supplemental answers to Interrogatory Nos. 40, 41, 42, and 43, and Document Request Nos. 15, 16, 17 within 5 days. Having received no response from applicant, on October 30, 2002, opposer filed a motion to compel discovery responses.

On October 28, 2003, applicant sent opposer a letter stating "we will provide to Pioneer all requested materials and information that Hitachi High Technologies has in its possession related to the use of the mark SUPERSCAN ELITE for computer monitors." In its response to the motion to compel, applicant contends that the motion to compel is moot; that applicant divested its entire business operations relating to computer monitors; that the divestiture included the personnel and records relating to computer monitors; and that, after investigation, applicant has none of the requested information or documents.

Insofar as applicant may not produce what it does not possess, opposer's first motion to compel is denied as moot.

On February 7, 2003, opposer filed a renewed motion to compel discovery responses. In support of its motion, opposer asserts that, by letter dated January 20, 2003, counsel for applicant informed counsel for opposer that applicant had found some documents and received 400 storage boxes of documents "which may relate to sales of Superscan and Supercan Elite monitors", requested counsel for opposer to "identify which interrogatories and document requests are incorrect and why you think they are incorrect", and indicated that "if the responses are incorrect and if the requests are not objectionable, we will supplement our prior answers"; that, in an effort to resolve the outstanding discovery issues, on January 24, 2003, opposer identified for applicant the discovery requests which needed to be supplemented; that counsel for applicant informed counsel for opposer by letter dated January 27, 2003 that the discovery responses would be reviewed to determine whether any revision was necessary; and that as of the filing of the renewed motion, opposer had received neither a written response nor supplemental responses.

In its opposition to the renewed motion to compel, filed February 21, 2003, applicant contends that, subsequent to informing opposer that the requested information might

not be available due to applicant's corporate restructuring, applicant discovered it had numerous boxes of documents related to the computer monitor operations; that applicant advised opposer of these documents and offered to make them available for inspection; that the parties agreed to review the documents on March 5, 2003; that, through a deposition opposer has already obtained testimony about the sales, advertising, channels of trade of SUPERSCAN ELITE computer monitors both before and after the time the operations were divested, and received three boxes of supporting documents; that applicant possesses no information beyond what is contained in the documents to be produced on March 5, 2003; and that the renewed motion to compel is moot because applicant has made available to opposer the newly discovered documents.

We agree with applicant that an order to compel discovery responses regarding applicant's use of its mark on computer monitors is unnecessary. In view of applicant's supplement of its initial responses, opposer's renewed motion to compel is also denied as moot.

Discovery and trial dates are reset as follows:

DISCOVERY to close

June 6, 2003

30-day testimony period for party in position of plaintiff to close:

September 4, 2004

30-day testimony period for party in position of defendant to close:

November 3, 2003

15-day rebuttal testimony period for
plaintiff to close:

December 18, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.